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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/685,305	10/10/2000	Kean M. Anspach	A148 1540 (16164.0590.)	4349

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

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DATE MAILED: 02/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/685,305

Applicant(s)

ANSPACH, KEAN M.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 and 35-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 18-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ✓
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 ✓
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-17 are drawn to repositionable surface covering adhesive sheets, classified in class 428, subclass 343.
 - II. Claims 18-34, are drawn to repositionable surface covering non-stringing adhesive sheets, classified in class 428, subclass 343.
 - III. Claims 35-54, drawn to methods of making a self-adhering surface covering, classified in class 156, subclass 60+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because non-stringing adhesive is only one special group of the adhesives could be used in the instant invention. The subcombination has separate utility such as heat activated hot-melt adhesive.

Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2)

that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the method of making repositionable adhesive sheets as claimed can be employed to make materially different product, such as a display posters.

Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the method of making repositionable adhesive sheets as claimed can be employed to make materially different product, such as a display posters.

Because these inventions are distinct for the reasons given above and the search required for Invention I is not required for Invention II, restriction for examination purposes as indicated is proper.

Because these inventions I and III, and II and III are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Steven Schmidt on February 4, 2002 a provisional election was made without traverse to prosecute the invention of II, claims 18-34. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-17 and 35-54 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 31, line2, after "layer", delete "is".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 18-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keely et al. (US 6194064B1) in view of the admitted prior art.

Keely's invention relates to pressure sensitive adhesives used in wallcoverings, borders, appliques and the like (column 1, lines 7-9). Keely teaches in a preferred embodiment, a non-stringing pressure sensitive adhesive is made from a plurality of water based acrylic or acrylic copolymer emulsions that give a balance of properties providing good anchorage of the wallcovering to a wall surface (column 3, lines 27-32).

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Keely also teaches a preferred embodiment of the adhesive which contains a plurality of hollow glass bubbles having a density and size suitable for being present at the surface of the pressure sensitive adhesive and which will reduce initial tack to allow movement of the wallcovering on the wall surface (column 3, lines 38-41). Further, Keely teaches that repositionable wallcovering allows for the movement of the decorative sheet on a surface, such as a wall, before the wallcovering is anchored to the surface.

Repositionability allows for positioning a decorative sheet on the surface and for the matching of patterns between adjacent decorative sheets. After positioning, a user applies moderate pressure to crush the hollow glass bubbles and create a bond between the PSA of the adhesive on the wallcovering with the wall surface (column 3, lines 66-67, and column 4, lines 1-8).

With respect to claims 18, 28-29 and 34, Keely shows all the features of the instant claimed invention except for the specific pressure required to crush the non-adhesive particles of the barrier layer and the tackiness of the pressure sensitive adhesives. Since Keely's teaching of crushing the hollow glass bubbles and creating a bond between the PSA of the adhesive on the wallcovering with the wall surface suggests there is an optimum pressure for crushing the non-adhesive particles in the barrier layer, and the adhesives used in the instant claimed invention are known (Specification, page 6, line 20), it would have been obvious to one having ordinary skill in the art at the time the invention was made to select an optimized combination of crushable particles for the barrier layer and suitable pressure sensitive adhesives with proper thermal properties to make the surface coverings. It has been held that where

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general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

With respect to claims 19-20, the Applicant states prior art to make repositionable pressure-sensitive adhesive tape or sheet by randomly (Specification, page 1, line 29) or uniformly distributing (a pattern) non-adhesive materials (Specification, page 2, line 25) on the surface. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make a repositionable surface covering as taught by Keely with randomly distributed or desired pattern of non-adhesive crushable particles in the barrier layer, as admitted prior art, motivated by uniform adhesive property or regional adhesive property to meet specific product requirements, and by the expectation of success imparted by the teachings of the prior art.

With respect to claims 21-23, Keely teaches the diameter of the hollow glass bubbles must be greater than the thickness of the pressure sensitive adhesive to provide for the contact of the hollow glass bubbles with the wall surface when applying and positioning the wallcovering (column 3, lines 42-46). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make a repositionable surface covering as taught by Keely with the size of crushable non-adhesive particles in the barrier layer being about equal or greater than the thickness of the pressure sensitive adhesive, motivated by providing the repositionability of the wallcovering, and by the expectation of success imparted by the teachings of the prior art.

With respect to claims 24-27, although Keely is silent about the amount of the particles used, it would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the amount and also the percent of surface covered by the crushable particles, motivated by optimum achievable adhesion strength and cost control.

With respect to claims 30, Keely discloses that the adhesive thickness within the range of about 40 to 177 microns (column 8, lines 59-61). Alternatively, the Examiner takes Official notice that for repositionable adhesive sheets, the thickness of the adhesive layer between about 1 to about 2 mils is a typical conventional range. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make repositionable adhesive sheets with the thickness of the adhesive layer between about 1 to about 2 mils, since it was known in the art this is a suitable range for the crushable non-adhesive particles to function properly.

With respect to claims 31-32, the Applicant has admitted that these are known conventional adhesives from prior art (Specification, page 6, lines 20-21). As such, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art to use these conventional adhesives to make the surface covering adhesive sheet as taught by Keely, since it was known in the art.

With respect to claim 33, the Fig 1 of Keely's invention clearly shows that the crushable particles are partially embedded in the adhesive layer. Therefore, it would have been obvious to one having ordinary skill in the art to make a repositionable pressure sensitive adhesive sheet with partially embedded non-adhesive crushable

particles as taught by Keely, motivated by its repositionability, and by the expectation of success imparted by the teachings of the prior art.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition, the following references are cited of interested for making repositionable surface covering adhesive sheet:

US 5487929 to Rusincovitch, Jr. et al.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0771 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC
VSC
February 4, 2002

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300-
1700

Daniel Zinker